

REMARKS

The above-identified application is filed herein as a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. The accompanying amendment and remarks respond to the Final Office Action mailed March 3, 2006 ("Office Action") and the Advisory Action mailed June 15, 2006 ("Advisory Action"). The present RCE is timely filed by August 3, 2006 by virtue of the accompanying petition for a two month extension of time. Reconsideration of the rejections is respectfully requested in light of the forgoing amendments and following remarks.

Rejections Under 35 U.S.C. § 103:

Claims 1, 3 – 5, 7 – 11, 14 – 24, 26 – 28, 30, 31 and 34 – 38 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,729,797 B2 ("Manger") in view of U.S. Patent No. 5,544,974 ("Berg") and U.S. Patent No. 6,886,388 B1 ("McGill"). Applicants traverse the rejection.

The grounds for the rejection set forth in the Office Action and Applicants' response in their Request for Reconsideration filed May 18, 2006, are incorporated herein by reference. In summary, Applicants stated: (1) to one of ordinary skill in the art, the teachings of Manger only would have suggested the use of a gas as the monitoring fluid, contrary to the recited use of a monitoring liquid reservoir in liquid communication with the annular space; (2) U.S. Patent No. 5,345,813 ("Flessas"), which evidences the state of the art at the time of the invention, teaches away from using a liquid to test for leaks in underground storage devices; and (3) the secondary references, Berg and McGill, do not make up for the deficiencies in the teachings of Manger.

In the Advisory Action, p. 2, the Examiner responded as follows:

In response to Applicant's statement that all pending claims positively recite "a monitoring liquid reservoir in liquid communication with the annular space," the Examiner contends that "in liquid communication" is not a positive recitation of a liquid. Therefore, for the purposes of prosecution on the merits, only claim 10 positively recites a liquid (i.e., brine).

In response to Applicant's statement that Manger et al. '797 suggests the use of gases for detecting leaks by measuring the pressurization or depressurization, the Examiner contends that the use of liquids is not precluded in such a monitoring system because pressurization and depressurization are not limited to gases.

In response to Applicant's statement that the use of a vacuum as taught by Manger et al. '797 implies the interstitial fluid "can only be a gas," the Examiner contends that a vacuum is merely suction created by a region of low pressure and is applicable to gases and liquids.

In response to Applicant's statements regarding Flessas, the Examiner notes that this reference was not relied upon in the Final Rejection and, therefore, any arguments relating to the same are irrelevant.

The first paragraph of the remarks in the Advisory Action clarifies the Examiner's position in the Office Action that "Applicant only positively recites a liquid in Claim 10." Office Action, p. 7. In the interest of expediting prosecution and without necessarily acquiescing to the Examiner's interpretation of the claim terms, Applicants presently amend independent Claims 1 and 22 to recite in part that the annular space contains a liquid and that the monitoring liquid reservoir contains a liquid in communication with the liquid in the annular space. Applicants believe that this amendment fully responds to the Examiner's requirement for a positive recitation of a liquid.

From the second and third paragraphs of the Examiner's remarks in the Advisory Action noted above, it is Applicants' understanding that the Examiner alleges that the artisan of ordinary skill at the time of the invention would have used liquids for detecting leaks by measuring the liquid pressurization or depressurization, in the same manner as gases, because pressurization and depressurization are not limited to gases. If the

Application Serial No.: 10/796,198

Examiner believes that an interview would help clarify the grounds for rejection, Applicants earnestly request the same.

The rejection improperly bases the motivation for the proposed combination of references on conclusory statements regarding the level of skill in the art at the time of the invention. In this same context, the Examiner's reviewing court has stated that the "factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). It is well established that "when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *Lee*, 277 F.3d at 1343 (citations omitted). In the present case, the rejection is improper without evidence on the record that the artisan of ordinary skill would have used liquids for detecting leaks in underground storage systems by measuring the liquid pressurization or depressurization, as alleged.

Not only does the rejection fail to provide the necessary evidence on the record, but it fails to respond to *contrary evidence from the primary reference* that one of ordinary skill in the art would have used pressurization and depressurization of a **gas** to detect leaks. Stating again Applicants' arguments from the Amendment, Manger would have suggested to the artisan of ordinary skill that the test fluid should be a gas. Specifically, Manger suggests using gas as the interstitial fluid, for example, at Col. 8, lines 13 – 14, which discusses forming an *airtight* seal between an outer boot **114** and a

pipe 148. Manger further suggests using a gas at Col. 7, lines 54 – 65, which discusses a sealable test port 141:

A sealable test port 141 of a type well known in the field is disposed on the first section 132 of the inner boot 116 to provide a fluid pathway into the area defined between the inner and outer boots. The test port 141 may be molded as part of the inner boot 116 or may be mechanically attached, for example, by tension or compression thread between the boot 116 and the test port 141. The test port 141 may have a threaded portion 142 adapted to connect to a conventional source of pressurized air. Alternatively, the threaded portion 142 may be connected to a conventional vacuum or under-pressure source adapted to remove fluid from the fitting interstitial space 160.

The specification provides that the test port may be adapted to connect to a source of *pressurized air* (lines 61 – 62) or to a *vacuum* or the like (line 63). In either embodiment, the interstitial fluid can only be a gas, not a liquid. The rejection provides no contrary evidence that teachings of an airtight seal, pressurized air, and a vacuum would have suggested anything to the artisan of ordinary skill other than the use of a gas to detect leaks. Accordingly, the rejection does not provide the required evidence on the record to support its conclusions regarding the level of ordinary skill in the art and should be withdrawn.

Finally, the Examiner states that the rejection does not rely on Flessas and alleges that any arguments relating to Flessas are thus irrelevant. It is well established that a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *See generally* M.P.E.P. § 2141.02 (VI), 8th ed., revised October 2005 (discussing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983)). The teachings of Flessas thus are highly relevant to what the references would have taught, motivated or suggested to one of ordinary skill in the art. First, Flessas provides evidence of the level of skill in the art at the time of the invention.

Application Serial No.: 10/796,198

See, e.g., Lee, 277 F.3d at 1343. For the reasons stated in the Amendment, Flessas teaches away from the claimed invention. Second, Flessas has added relevance as part of the disclosure (by way of incorporation by reference) of Manger, the primary reference used in the rejection. Accordingly, it is legal error to hold otherwise on the sole basis that the teachings of Flessas were not relied upon in the rejection, and the rejection thus should be withdrawn.

CONCLUSION

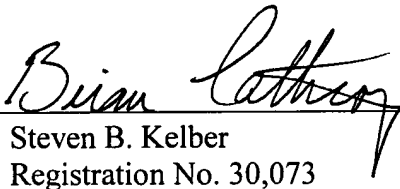
In view above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.

July 25, 2006

Date


Steven B. Kelber
Registration No. 30,073

P.O. Box 2903
Minneapolis, Minnesota 55402-0903
Telephone No. (202) 326-0300
Facsimile No. (202) 326-0778

Brian K. Lathrop
Registration No. 43,740

23552

Patent & Trademark Office